

REMARKS

1. An Office Action requiring Applicants to elect a single invention for prosecution on the merits was mailed August 1, 2006. In response to the Election/Restriction Requirement, Applicants submit this Response to Election/Restriction Requirement.

Restriction Requirement

2. The Examiner has required the election of a single invention for prosecution on the merits. The Examiner alleged that the originally filed claims are directed to the following two (2) patentably distinct inventions:

- I.* Claims 1 through 30, drawn to a method of making an electrical contact, classified in class 29.
- II.* Claims 31 through 50, drawn to an electrical contact, classified in class 439, subclass 587.

Election of Species

3. The Examiner has required the election of species from each of the following nine species as disclosed in the drawings.

- Specie 1: Fig. 1;
- Specie 2: Figs. 4-6;
- Specie 3: Fig. 7;
- Specie 4: Fig. 10c;
- Specie 5: Fig. 14;
- Specie 6: Fig. 15;
- Specie 7: Fig. 16;
- Specie 8: Fig. 17; and
- Specie 9: Fig. 20;

Traversal of Restriction Requirement

4. Applicants respectfully traverse the requirement to restrict the claims pending in the present application prior to entry of this paper. "There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and (B) There must be a serious burden on the examiner if restriction is

required (see MPEP § 803.02, § 806.04(a) -§ 806.04(i), § 808.01(a), and § 808.02)." (See, MPEP § 803.) Applicants respectfully assert that, for at least the reasons set out below, the above restriction fails to satisfy the above criteria, and should be withdrawn.

***The Examiner Has Failed To Provide Sufficient Reasoning
For Restricting The Claimed Invention***

5. As explained in the MPEP: "Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; ..." (See, MPEP § 808; emphasis in original.) "The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given." (See, MPEP § 816.)

6. Applicants assert that no such reasoning has been provided to support the outstanding Restriction Requirement. In the current Office Action, the Examiner has asserted that the inventions are distinct because they are related as apparatus for making a product and the product made by the apparatus, and that "the contact can be [made] by [a] different method." The Examiner relies on MPEP § 806.05(g) in which it is stated that the apparatus and product inventions are distinct when the product as claimed can be made by another and materially different apparatus.

7. The Examiner has failed to show how the claimed products may be made by an apparatus that is materially different than the claimed apparatus. The Examiner's assertion that a "different method" may be used to make the contacts is unsupported by the record of this application. In addition, even if this assertion were true, such a fact does not necessarily dictate that the claimed product can be made "by another and materially different apparatus." Because the outstanding Restriction lacks any such support, Applicants assert the Restriction of is improper and should be withdrawn.

***The Examiner Has Failed To Show The Necessary Burden
To Examine All Pending Claims***

8 As noted above, there must be “a serious burden on the examiner if restriction is required.” (See, MPEP § 803.) This is a separate and distinct requirement that must be shown by the Examiner: “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” (See, MPEP § 803.) In the above Restriction Requirement the Examiner has failed to provide any such showing. Further, Applicants respectfully assert that a search performed for any independent claim pending in the application would uncover references potentially relevant to other independent claims. Accordingly, Applicants assert that this burden cannot be met and, for this additional reason, the requirement should be withdrawn.

Provisional Election

9. In accordance with 37 CFR § 1.143 and MPEP 818.03(b), Applicants hereby provisionally elect, with traverse, the claims of Group I, namely, claims 1-30.

10. With regard to the species election, Applicants elects Specie 1. However, Applicants respectfully assert that Specie 1 encompasses not only Fig.1 but also Figs. 2 and 3 (which were not included in any other species).

11. Applicants do not intend to dedicate non-elected claims to the public and reserve the right to file divisional applications for the subject matter covered by the non-elected claims.

12. The inventorship for the invention of the elected claims is the same as the inventorship of record in this application.

Conclusion

13. In view of the foregoing, it is respectfully submitted that this application is in condition for allowance and favorable action is respectfully solicited.

Respectfully submitted,



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